

REMARKS

Claims 1-8, 10, 11 and 13-41 are pending in the application.

Claims 25-32 are rejected under 35 U.S.C. §112, second paragraph.

Claims 1-8, 10, 11 and 13-41 are rejected under 35 U.S.C. §103.

Applicant amended claims 25 and 29 as indicated above. Applicant notes that claims 25 and 29 were not amended to overcome prior art but to correct a typographical error. Hence, the amendments made to claims 25 and 29 were not narrowing in scope (in fact the amendment broadened claims 25 and 29) and therefore no prosecution history estoppel arises from the amendments to claims 25 and 29. *Festo Corp v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 62 U.S.P.Q.2d 1705, 1711-1712 (2002); 56 U.S.P.Q.2d 1865, 1870 (Fed. Cir. 2000). Further, the amendments made to claims 25 and 29 were not made for a substantial reason related to patentability and therefore no prosecution history estoppel arises from such amendments. See *Festo Corp.*, 62 U.S.P.Q.2d 1705 at 1707 (2002); *Warner-Jenkinson Co. v. Hilton Davis Chemical Co.*, 41 U.S.P.Q.2d 1865, 1873 (1997).

Applicant respectfully traverses these rejections for at least the reasons stated below and respectfully requests the Examiner to reconsider and withdraw these rejections.

I. REJECTIONS UNDER 35 U.S.C. §112:

The Examiner has rejected claims 25-32 under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter with Applicant regards as the invention. Paper No. 18, page 3. In

particular, the Examiner asserted that the term "conventional" in claims 25 and 29 was vague and indefinite. Paper No. 18, page 3. Applicant has amended claims 25 and 29 to remove the term "conventional." Accordingly, Applicant asserts that claims 25-32 are allowable.

II. REJECTIONS UNDER 35 U.S.C. §103(a):

The Examiner has rejected claims 1, 10, 16-20, 33 and 40 under 35 U.S.C. §103(a) as being unpatentable over Gramlich (U.S. Patent No. 5,826,025) in view of Day et al. (U.S. Patent No. 6,243,722) (hereinafter "Day"). The Examiner has further rejected claims 2-8, 11, 13-15, 34-38 40 under 35 U.S.C. §103(a) as being unpatentable over Gramlich in view of Day and in further view of Tran (U.S. Patent No. 6,054,990). The Examiner has further rejected claims 21-24, 39 and 41 under 35 U.S.C. §103(a) as being unpatentable over Gramlich in view of Day in further view of Tran and in further view of Merritt et al. (U.S. Patent No. 6,041,335) (hereinafter "Merritt"). The Examiner has further rejected claims 25-32 under 35 U.S.C. §103(a) as being unpatentable over Gramlich in view of Tran and in further view of Merritt. Applicant respectfully traverses these rejections for at least the reasons stated below and respectfully requests the Examiner to reconsider and withdraw these rejections.

A. Rejections to claims 1-8, 10, 11, 13-24 and 33-41 are moot under 35 U.S.C. §103(c).

The Examiner has rejected 1-8, 10, 11, 13-24 and 33-41 under 35 U.S.C. §103(a) as being unpatentable over Day in combination with other references as listed above. Paper No. 18, pages 4, 7 and 9. The reference Day, which may qualify as prior art under 35 U.S.C. § 102(e), does not preclude patentability under 35 U.S.C. § 103 since Day and the claimed invention in claims 1-8, 10, 11, 13-24 and 33-41 were at the time the invention was made, subject to an obligation of assignment to the same person, which in this case was International Business

Machines Corporation. 35 U.S.C. § 103(c). Thus, Day is disqualified as being used as a prior art reference under 35 U.S.C. § 103(c). Consequently, the rejections of claims 1-8, 10, 11, 13-24 and 33-41 are moot.

**B. Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest the following claim limitations.**

Applicant respectfully asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "computer readable program code means for causing a computer to parse a selected one of the set of source files into a linked list of objects corresponding to a hypertext presentation of the selected source file" as recited in claim 25. The Examiner cites column 15, lines 30-39 of Tran as teaching the above-cited claim limitation. Paper No. 18, page 9. Applicant respectfully traverses and asserts that Tran instead teaches a routine to edit the objects drawn that includes the step of determining if the user wishes to flip graphical objects, e.g., magnifier 108 (Figure 2). If so, the routine flips the graphical objects. Further, the routine allows the user to enter text and to associate the text with selected graphical objects by adding the text to the linked list data structure for the objects. This language is not the same as parsing a selected one of a set of source files into a linked list of objects. There is no mention of parsing in Tran. Applicant has performed a word search of "parse" and "parsing" in Tran and was unable to identify the word "parse" or "parsing" or any variation thereof in Tran. Further, the cited passage does not teach a linked list of objects corresponding to a hypertext representation of a selected source file. Applicant has performed a word search of "hypertext" in Tran and was unable to identify the word "hypertext" or any variation thereof in Tran. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "the linked list further comprising comment insertion objects and comment display objects, the parser writing the linked list of objects to a binary markup file representing the linked list of objects and corresponding to the selected one of the set of source files, each comment display object associated with one or more comments" as recited in claim 25. The Examiner has not cited any passage in either Gramlich, Tran and Merritt as teaching the above-cited claim limitations. The Examiner is reminded that the Examiner bears the initial burden of presenting a *prima facie* case of obviousness. *In re Oetiker*, 977 F.2d 1443, 1445, 24 U.S.P.Q.2d 1443, 1444 (Fed. Cir. 1992); M.P.E.P. §2142. Since the Examiner has not provided any evidence that Gramlich, Tran and Merritt, taken singly or in combination, teach or suggest the above-cited claim limitations, the Examiner has not presented a *prima facie* case of obviousness. M.P.E.P. §2143.

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "computer readable program code means for causing the computer to accept new comments for inclusion in the set of comments associated with a reviewer-defined source file and to update the associated comment file" as recited in claim 25. The Examiner cites column 7, lines 35-45 and column 8, lines 40-50 of Gramlich as teaching the above-cited claim limitation. Paper No. 18, page 5. Applicant respectfully traverses and asserts that Gramlich instead teaches individuals contributing annotation overlays to one or more overlay groups. Gramlich further teaches that these annotation overlays are stored on overlay servers. Abstract. Gramlich further teaches that an annotation proxy merges with the retrieved documents (documents requested by a user of a web browser) commentary from sources designated by the user of the web browser that refers to the requested documents. Gramlich further teaches that the annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays

from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. Abstract. Gramlich further teaches that alternatively, the annotation proxy can perform the merge operation on the fly by pulling the annotation overlays directly from the Web servers without the use of a local annotation directory. While Gramlich teaches storing the annotations on servers, Gramlich does not teach including new comments in a reviewer-defined source file and to update the associated comment file. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "the hypertext document selectively including hypertext links representing comment insertion objects, the hypertext links providing reviewers with forms for reviewer entry of comments" as recited in claim 25. The Examiner cites column 12, lines 25-35 of Gramlich for teaching common insertion objects and cites column 5, lines 1-6 and 64-67 and column 6, lines 1-17 of Merritt as teaching providing reviewers with forms for reviewer entry of comments. Paper No. 18, pages 8 and 11. Applicant respectfully traverses and asserts that Merritt instead teaches that a primary image, e.g., a memo to staff (Figure 2), is transmitted to other users in a routing list. The first user transmits the primary image to a first subsequent user, indicated in the routing list, so that they can review the primary image and input their annotations using the glyphs or marks by adding new annotations identified by a glyph or mark. After review by the subsequent user, the annotated primary image is transmitted to the next subsequent user for their review and annotation input and so forth. This language is not the same as providing reviewers with forms for their review. Instead, the users in Merritt are provided with the document itself where they can make annotations to that document. But Merritt

does not provide the users with a form for reviewer entry for comments. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "the hypertext document selectively including hypertext data for calling the common gateway interface program for generating a hypertext document and the hypertext document selectively including hypertext data for calling the common gateway interface program for accepting new comments" as recited in claim 25 and similarly in claim 29. The Examiner cites column 5, lines 12-15; column 7, lines 35-45 and column 8, lines 40-50 of Gramlich as teaching the above-cited claim limitation. Paper No. 18, page 10. Applicant respectfully traverses and asserts that Gramlich instead teaches that a list of sources can be submitted to a browser using a common gateway interface. This language is not the same as a hypertext document including hypertext data for calling a common gateway interface program. The cited passages do include any language that teaches a hypertext document including data that is used for calling a common gateway interface program. Further, the cited passages do not teach a hypertext document that includes data for calling a common gateway interface program for generating a hypertext document. Further, the cited passages do not teach a hypertext document selectively including hypertext data for calling a common gateway interface program for accepting new comments. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Claims 26-28 and 30-32 each recite combinations of features including the above combinations, and thus are patentable for at least the above stated reasons.

Claims 26-28 and 30-32 recite additional features, which, in combination with the features of the claims upon which they depend, are patentable over Gramlich in view of Tran in further view of Merritt.

For example, Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "the linked list of objects comprises objects appropriately selected from the set of objects comprising simple tag objects, tag objects, end tag objects, text objects, comment insertion objects, comment display objects, complex whitespace objects, spaces objects, newlines objects, hypertext comment objects, ordered list item objects and link tag objects" as recited in claim 27 and similarly in claim 31. The Examiner cites column 15, lines 30-39 of Tran as teaching the above-cited claim limitation. Applicant respectfully traverses and asserts that Tran instead teaches that the user may enter text and to associated the text with a selected object, e.g., image displayed on a display. The cited passage includes no language regarding the type of objects. For example, the cited passage has no reference to tag objects, tag objects, end tag objects, text objects, comment insertion objects, comment display objects, complex whitespace objects, spaces objects, newlines objects, hypertext comment objects, ordered list item objects and link tag objects. Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Further, the Examiner's motivation for modifying Gramlich to include a linked list of objects that comprises objects appropriately selected from the set of objects comprising simple tag objects, tag objects, end tag objects, text objects, comment insertion objects, comment display objects, complex whitespace objects, spaces objects, newlines objects, hypertext comment objects, ordered list item objects and link tag objects is to provide "a user of Gramlich with a way to dynamically store and

manipulate objects." Paper No. 18, page 8. This motivation is insufficient to support a *prima facie* case of obviousness since it is merely the Examiner's subjective opinion.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to include a linked list of objects that comprises objects appropriately selected from the set of objects comprising simple tag objects, tag objects, end tag objects, text objects, comment insertion objects, comment display objects, complex whitespace objects, spaces objects, newlines objects, hypertext comment objects, ordered list item objects and link tag objects. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to dynamically store and manipulate objects. *Id.* Therefore, the Examiner has not presented a *prima facie* showing of obviousness for rejecting claims 27 and 31.

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "each object in the linked list of objects has a type, and comprises contents derived from a portion of the source file, each comment insertion object and each comment display object comprises a contents line identifier, representing the line number defining the location of the object in relation to the source file, the comment file consists of comment line identifier data associated with the set of comments representing the line numbers in the source file with which each comment is related, and in which the computer readable program code means for causing the computer to generate a hypertext document further comprises means to traverse the linked list of objects, and means to select a display object from the linked list of objects, means to determine the type of the display object, means to generate hypertext data to correspond to the type of the display object and the contents of the



display object, means to identify the contents line identifier for the display object and for selecting comment display data from the comment file based on the contents line identifier and the comment line identifiers of the comment file, and means to generate hypertext data from the comment file representing the selected one of the set of comments corresponding to the comment line identifier associated with the contents line identifier" as recited in claim 28 and similarly in claim 32. The Examiner cites the Abstract; column 3, lines 65-67; column 4, lines 43-50 and column 12, lines 32-42 of Gramlich as teaching the above-cited claim limitations. Paper No. 18, page 8. Applicant respectfully traverses and asserts that Gramlich instead teaches a system and method for providing annotation overlays from diverse sources of commentary for World-Wide Web documents. Abstract. Gramlich further teaches that sources of commentary contribute annotation overlays regarding particular documents on the World-Wide Web. Gramlich further teaches that the annotation overlays from a particular source are stored on one or more overlay servers, which are connected to the Web. Gramlich further teaches that a user of a Web browser opens an annotation proxy server between the Web browser and the Web servers that intercepts all documents retrieved by the Web browser and merges with the retrieved documents commentary from sources designated by the user of the Web browser that refer to the requested documents. Gramlich further teaches that the annotation proxy can perform the merge operation by first creating a local annotation directory of annotation overlays from sources designated by the user then, when the user requests a document, merging with the requested document information only from the annotation directory. Gramlich further teaches that alternatively, the annotation proxy can perform the merge operation on the fly by pulling the annotation overlays directly from the Web servers without the use of a local annotation directory. Applicant respectfully points out that the relevancy of the cited passages with respect to the above-cited claim limitations is not apparent. Applicant respectfully asserts that the

Examiner must clearly explain the relevancy of the cited passage with respect to the above-cited claim limitations, pursuant to 37 C.F.R. §1.104(c)(2). Therefore, the Examiner has not presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

Applicant further asserts that Gramlich, Tran and Merritt, taken singly or in combination, do not teach or suggest "in which each one of the comment display objects comprises open tag data representing the open hypertext tags, at the location of the comment display object, in the linked list of objects, and in which the computer readable program code means for causing the computer to generate a hypertext document further comprises means to insert closing hypertext data in the hypertext document, prior to a selected one of the comments being displayed in the hypertext document, and means to insert reopening hypertext data in the hypertext document, following the selected one of the comments being displayed in the hypertext document, the closing hypertext data and the reopening hypertext data both being defined by the open tag data for the comment display object associated with the selected one of the comments being displayed" as recited in claim 31. The Examiner cites column 12, lines 25-35 of Gramlich as teaching the above-cited claim limitation. Paper No. 18, page 8. Applicant respectfully traverses and asserts that Gramlich instead teaches that the annotation overlay proxy adds an HTML tag to call out the annotation and links the appended information from the arg field to that tag. Gramlich further teaches that the annotation overlay proxy also inserts HTML tags in the merged document around the pattern to convert the pattern into a hyperlink cue tied to the appended information from the arg field. The cited passage does not include language that teaches a linked list of objects. Hence, the cited passage does not teach an open tag data representing the open hypertext tags at the location of the comment display object in the linked list of objects. Therefore, the Examiner has not

presented a *prima facie* case of obviousness, since the Examiner is relying upon an incorrect, factual predicate in support of the rejection. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1455 (Fed. Cir. 1998).

As a result of the foregoing, Applicant respectfully asserts that there are numerous claim limitations not taught or suggested in the cited prior art, and thus the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 25-32 as being unpatentable over Gramlich in view of Tran in further view of Merritt.

**C. The Examiner has not provided any objective evidence for combining Gramlich with Tran and Merritt.**

A *prima facie* showing of obviousness requires the Examiner to establish, *inter alia*, that the prior art references teach or suggest, either alone or in combination, all of the limitations of the claimed invention, and the Examiner must provide a motivation or suggestion to combine or modify the prior art reference to make the claimed inventions. M.P.E.P. §2142. The showings must be clear and particular. *In re Lee*, 277 F.3d 1338, 1343, 61 U.S.P.Q. 2d 1430, 1433-34 (Fed. Cir. 2002); *In re Kotzab*, 217 F.3d 1365, 1370, 55 U.S.P.Q. 2d 1313, 1317 (Fed. Cir. 2000); *In re Dembiczak*, 50 U.S.P.Q.2d. 1614, 1617 (Fed. Cir. 1999). Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

In order to reject under 35 U.S.C. § 103, therefore, the Examiner must provide a proper motivation for combining or modifying the references. *In re Rouffet*, 47 U.S.P.Q.2d 1453, 1457-1458 (Fed. Cir. 1998); M.P.E.P. § 2142. The Examiner's motivation for modifying Gramlich with Tran to represent a source file as a linked list of objects, as recited in claim 2 and similarly in claims 25 and 29, is "to dynamically store files." Paper No. 18, page 7. Further, the Examiner's motivation for modifying Gramlich with Merritt for providing reviewers with forms for reviewer entry of

comments, as recited in claims 25 and 29, is to provide the "users of Gramlich the benefit of inspecting and commenting upon previous comments made to a document." Paper No. 18, page 11. These motivations are insufficient to support a *prima facie* case of obviousness since they are merely the Examiner's subjective opinion.

Gramlich teaches a system and method for providing annotation overlays from diverse sources of commentary for World-Wide Web documents. Abstract. Gramlich further teaches that the annotation overlays are stored on one or more overlay servers, which are connected to the Web. Abstract.

Tran, on the other hand, teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. Abstract.

Merritt, on the other hand, teaches superimposing a second, graphical image on a primary image for annotating the primary image. Abstract. Merritt further teaches that the secondary image is displayed over the primary image as either a mark or glyph. Abstract.

The Examiner must submit objective evidence and not rely on his own subjective opinion in support of combining a reference that teaches providing annotation overlays from diverse sources of commentary for World-Wide Web documents, with a reference that teaches a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen, with a reference that teaches superimposing a second, graphical image on a primary image for annotating the primary image. *In re Lee*, 61 U.S.P.Q.2d 1430, 1434 (Fed. Cir. 2002). Further, the Examiner must submit objective evidence

and not rely on his own subjective opinion in support of modifying Gramlich to represent a source file as a linked list of objects. *Id.* Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to provide reviewers with forms for reviewer entry of comments. *Id.* Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to dynamically store files. *Id.* Further, the Examiner must submit objective evidence and not rely on his own subjective opinion in support of modifying Gramlich to provide the benefit of inspecting and commenting upon previous comments made to a document. *Id.* Therefore, the Examiner has not presented a *prima facie* showing of obviousness for rejecting claims 25-32.

**D. By combining Gramlich with Tran, the principle of operation of Gramlich would change.**

If the proposed modification or combination of the prior art would change the principle of the operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 U.S.P.Q. 1125 (Fed. Cir. 1984). For the reasons discussed below, Applicant submits that by combining Gramlich with Tran, the principle of operation in Gramlich would change and subsequently render the operation of Gramlich to perform its purpose unsatisfactory.

As stated above, Gramlich teaches a system and method for providing annotation overlays from diverse sources of commentary for World-Wide Web

(WWW) documents. Abstract. Gramlich further teaches that the annotation overlays are stored on one or more overlay servers, which are connected to the Web.

Tran, on the other hand, teaches that the ability to quickly create and attach text or graphical illustrations to a message, file, data set or recording media is needed in many applications, including photographic annotation and two-way communications. Column 2, lines 59-62. Tran further teaches that existing cameras do not offer a light weight and reliable solution for recording camera settings and drawing/text annotations on the film. Column 4, lines 63-65. Further, Tran teaches that the ability to annotate a message with drawings is also important in the communications applications in the two-way messaging industry and the cellular communications industry. Column 4, line 66 - Column 5, line 2. Tran further teaches that the present invention provides a graphical data entry system for accepting and processing hand sketches and writings such that the user can quickly specify graphical objects in a drawing on a hand-held, mobile computer with a relatively compact screen. Column 5, lines 25-29. Tran further teaches that an object classification and recognition capability is provided to recognize objects being sketched by the user and to convert the hand sketches into CAD-like drawings. Column 5, lines 32-35. Tran further teaches that the graphical data entry system of the present invention can be used in conjunction with a camera to annotate pictures taken with the camera. Column 5, lines 39-41.

By combining Gramlich with Tran, Gramlich would no longer be able to store annotation overlays on servers that would be used to annotate a WWW document. Tran does not teach annotating a WWW document but instead teaches annotating a drawing or a photograph. Furthermore, Tran does not teach storing these annotations on a server but instead storing these annotations on the data entry graphical system displaying the photograph or drawing. Hence, by combining Gramlich with Tran, the

user in Gramlich would be annotating a drawing or photograph instead of a WWW document and would be storing these annotations on the user's data processing system. Thus, by combining Gramlich with Tran, the principle of operation in Gramlich would change, and subsequently render the operation of Gramlich to perform its purpose unsatisfactory. Therefore, the Examiner has not presented a *prima facie* case of obviousness for rejecting claims 25-32.

III. CONCLUSION

As a result of the foregoing, it is asserted by Applicant that claims 1-8, 10, 11 and 13-41 in the Application are in condition for allowance, and Applicant respectfully requests an allowance of such claims. Applicant respectfully requests that the Examiner call Applicant's attorney at the below listed number if the Examiner believes that such a discussion would be helpful in resolving any remaining issues.

Respectfully submitted,

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